

REMARKS

The present concepts expressed by Applicants' disclosure teach, for example, how to secure data, such as documents and drawings, shared by a plurality of machines (e.g., LAN). It is noted that every reference cited by the Examiner in the Office Action relates to counterfeiting of banknotes and similar valuable papers.

One significant difference between the claimed invention and the cited references is found in the step of updating and recording the updating history. Data shared through LANs, for example, are modified frequently (e.g., hour-by-hour or minute-by-minute) and the prohibition information has to be updated at rates according to the modification of data, whereas the prohibition information of banknotes and valuable papers is modified infrequently (yearly or monthly, at most). Thus, the paradigms or theoretical frameworks presented in such cited and applied references and the claimed invention are markedly different.

THE 35 U.S.C. § 103 REJECTIONS

The Office Action sets forth numerous rejections, set forth below:

I. Claims 1-3, 5, 8, 11-13, 17, 19 and 27-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hiraishi et al.** (JP 11-355562) (hereinafter "**Hiraishi**") in view of **Funada et al.** (JP 5-14706) (hereinafter "**Funada**").

II. Claims 4, 14-16 and 34-35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hiraishi** in view of **Funada** and **Takagi** (JP 5-282448).

III. Claims 7, 9-10, 18 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hiraishi** in view of **Funada** and **Ishii** (JP 2-073284).

IV. Claims 21-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hiraishi** in view of **Funada** and **Omura** (JP 4-03120561A).

V. Claims 30-33 and 36-37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Hiraishi** in view of **Funada** and **Ugai** (JP 4-06125459A).

1. **HIRAISHI DOES NOT CONSTITUTE PRIOR ART**

Each of the above rejections is traversed on the grounds that **Hiraishi** does not constitute prior art.

Hiraishi was filed in Japan on June 4, 1989, and then published under Japanese laid-open publication No. 11-355562 on December 24, 1999.

The present invention, on the other hand, claims a priority date of February 26, 1999. Thus, the present application has a priority date that predates the publication date of **Hiraishi**. Stated differently, **Hiraishi** is not available as a prior art reference under any of 35 U.S.C. § 102(a)(see, e.g., MPEP § 2132), 102(b) (see, e.g., MPEP § 2133), 102(d) (see, e.g., MPEP § 2135), or 102(e) (see, e.g., MPEP § 2136) or 35 U.S.C. § 103 (see, e.g., MPEP § 2141.01).

Therefore, each of the above rejections are legally insufficient in that the principal reference (i.e., **Hiraishi**) in each of the above rejections does not constitute prior art and the remaining combinations of references in each of the above rejections are factually and legally insufficient to teach or suggest each aspect of the claimed inventions and to sustain the asserted obviousness rejections under 35 U.S.C. § 103.

Applicants submittal of translations of the priority documents and a statement that the translation of the certified copy is accurate will be forthcoming to perfect priority.

Withdrawal of each of the above-noted rejections I-V is therefore requested for at least this reason.

2. REJECTIONS ARE PRIMA FACIE INVALID

It is noted that the Examiner cited numerous Japanese-language references, but did not provide copies of translations thereof or citations to subject matter assertedly contained in the underlying documents.

The Board of Patent Appeals and Interferences has often noted the "recurring problem" of "the citation and reliance by Examiners on abstracts, without citation and reliance on the underlying scientific document". *See Ex Parte Gavin*, 62 USPQ 1680, 1683 (Bd. Pat. App. & Inter. 2001) (Examiner relied upon abstracts of two published Japanese patent applications without referring to translations of the underlying applications); *Ex Parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (Examiner relied upon abstracts of three foreign-language journal articles without referring to translations of the underlying applications); *see also Ex Parte Bontils*, 64 USPQ2d 1456 (2002).

For good reason, the Board is critical of the evidentiary value of such English-language abstracts and conclusions gleaned therefrom. *See, e.g., Ex Parte Gavin* at 1684 (*stating* "an abstract does not provide enough information to permit an objective evaluation of the validity of what it describes They are little more reliable than headlines or brief newspaper articles"); *Ex Parte Jones* at 1208 (noting "[a]bstracts often are not written by the author of the underlying document and may be erroneous").

The above-noted rejections, which are not expressly stated in terms limiting the scope of the asserted "prior art" to only the English-language abstract, are improperly based upon underlying foreign language documents of which the Examiner has provided no translations and has asserted no personal knowledge thereof rather than the English-language abstracts thereof.

Withdrawal of each of the above-noted rejections I-V is therefore requested for at least the reason that proffered evidentiary support is facially invalid.

3. THE OBVIOUSNESS REJECTIONS ARE FACTUALLY AND LEGALLY INSUFFICIENT

The Examiner recognizes **Hiraishi** "does not teach copy inhibition information capable of being updated and stored in inhibition information storage" and cites **Funada** as teaching a "data monitoring method in which updating information of the copy inhibition information is provided passing through a network" (allegedly citing abstract constitution).

However, the English-language abstract of **Funada** does not teach or suggest, as alleged, a "data monitoring method in which updating information of the copy inhibition information is provided passing through a network". Instead, the English-language abstract of **Funada** states:

PURPOSE: To facilitate the decision of various specified pictures by constituting a picture processor of a means to hold the features of the registered specified pictures, the means to decide similarity between the feature of the inputted picture and the feature of the held specified picture, and the means to update held contents from the outside through a line.

CONSTITUTION: The decision of the various specified pictures is facilitated by constituting the picture processor of the means 302 to hold the features of the registered specified pictures, the means 303-1 to 303-8 to decide the similarity between the feature of the inputted picture and the feature of the held specified picture, and updating means 230 and 231 to update the held contents held by the means 302 from the outside through the line. Thus, the detection of the color distribution and the discrimination of the pattern matching of an object picture are made possible

Applicants submit that **Funada** is concerned with a logarithm, which is not the same as the log history of the present invention. Applicants submit that **Funada** (i.e., the underlying substantive document) instead relates to "logging" or *recording the procedures on the computer* (log-filing). Notably absent from **Funada's** English-language abstract is mention of a "network" upon which the Examiner repeatedly relies (see, e.g., Page 4 of Office Action). To the extent that the Examiner might be selectively interpreting or extrapolating the disclosed means to update held contents "from the outside through a line", the Examiner has not in fact shown any relation of **Funada** to a network and has not discharged the burden of showing that such a feature is necessary present therein (i.e., inherent). Accordingly, the Examiner has not discharged her burden to demonstrate that the combination of **Hiraishi** and **Funada** teaches or suggests each and every feature of the claimed invention, contrary to the Examiner's statement of rejections in reliance thereupon in each of numbered paragraph 6 of Paper No. 9.

Regarding claim 8, for example, increasingly enormous amounts of data are required to be handled in a big company and to be imparted with various security levels. Accordingly, a company's administrator or IS department must update the copy prohibition information concerned with said data frequently. The updating of the present invention (e.g., claim 8) is executed when the updating circuit 31 obtains the copy prohibition information from a server through network on the basis of the updating request from the updating circuit 31, for example. Such steps are described in the specification, page 28, line 9. Said updating request is issued when the power is ON, which is described in the specification, page 28, lines 16-20. Otherwise, the registration information requesting circuit 33 requests necessary copy prohibition information based on an instruction from the printing information analyzing circuit 48 then printing data is expanded on the image memory 46, and the steps are described in the specification, page 28, line

21 to page 29, line 3. Therefore, the present invention (e.g., claim 8) is arranged so that the updating of the copy prohibition information is executed whenever the copying is executed. Additionally, the copying device of the present invention does not need to be provided with a recording memory recording the copy prohibition information because it request the necessary information only and it is therefore possible to reduce cost. It is submitted that **Funada's** teaching of updating held contents "from the outside through a line" fails to state *when* an updating request is issued and does not teach or suggest "obtaining the copy inhibition information from a master information storage on a network by issuing a request if originals of said copy inhibition information are stored in the master information storage on the network" recited by claim 8 or claims depending therefrom.

Similarly, the English-language abstract of **Funada** has not been shown to teach or suggest a data monitoring device comprising "a log storage storing updating logs when the copy inhibition information in the inhibition information storage are updated; and in which the updating means obtains the latest copy inhibition information based on the logs of the updating information" (claim 17), "secrecy management means storing in the inhibition information storage secrecy management information in addition to the copy inhibition information, and controlling a copy inhibition or a inhibition cancel in accordance with secrecy management information and user's secrecy management level" (claim 18), or "a master information storage on the network storing originals of the copy inhibition information; and information obtaining means obtaining the copy inhibition information from a master information storage on a network by issuing a request if originals of said copy inhibition information are stored in the master information storage on the network" (claim 19).

The English-language abstract of **Funada** also has not been shown to teach or suggest a copying device receiving an monitoring object data from an external device and preparing a copy based on the monitoring object data, comprising: extracting means analyzing the monitoring object data and extracting unique information specifying a specific device concerned with the preparation of the monitoring object data; and specific information imparting means imparting the extracted unique information to the monitoring object data (claim 27) or such device "in which the unique information is an ID number specifying a personal computer" (claim 28) or "in which the unique information is an IP address imparted to a device." (claim 29).

It is submitted that the 35 U.S.C. § 103 rejection asserted in numbered paragraph 6 is improper for at least the above reasons and it is further submitted that each of the 35 U.S.C. § 103 rejections set forth in numbered paragraphs 7, 8, 9 and 10 of Paper No. 9 are predicated upon the factually insufficient combination of **Hiraishi** and **Funada** and such 35 U.S.C. § 103 rejections are submitted to fail for the same reasons asserted above.

Claim 7 recites a data monitoring method comprising: monitoring each copy element of monitoring object data consisting of at least one kind of copy element in accordance with at least one kind of copy inhibition information capable of being updated and stored in inhibition information storage; inhibition input or output of the monitoring object data if the monitoring determines that said each copy element agrees with a kind of said copy inhibition information; and controlling a copy inhibition of a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance.

Claim 7 is intended to encompass, for example, a document applied in a company is imparted with a security level depending on one's post or title to which an individual browsing

said document is assigned. Thus, there would exist documents that everyone could browse, documents that all of specific section members are allowed to browse, documents that specific titled persons of a specific section are allowed to browse, and so on. Such security level is imparted to each document or each part of said document (see Fig. 13). In order to cancel the "protected status" (for example, a status that a flag is standing) of a specific copy protected data, it is general that the protected status by inserting a specific person's card to the card slot. However, in case where a specific copy protected document is concerned with the security level of the document and an individual's post and title, like those in the present invention, it is necessary to decide whether the copy protection is cancelled or not by checking the security level of the document and an individual's attributes (his post and title).

Ishii, relied upon by the Examiner in the rejection of claims 7, 9-10, 18 and 20 fails to teach or suggest, as asserted, "controlling a copy inhibition of a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance" (claim 7), "controlling a copy inhibition or a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information obtained together with the copy inhibition information at the step of obtaining the information, said secrecy management information stored in the master inhibition information storage in addition to the original copy inhibition information in advance" (claim 9), "canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not" (claim 10), "secrecy management means storing in the inhibition information storage secrecy management information in addition to the copy inhibition information, and controlling a copy inhibition or a inhibition cancel in accordance with secrecy

management information and user's secrecy management level" (claim 18), or a master storage which "stores secrecy management information of each original information in addition to the copy inhibition information" and wherein "the information obtaining means obtains the copy inhibition information and the secrecy management information" and further comprising "secrecy management means controlling a copy inhibition or a inhibition cancel in accordance with the obtained secrecy management information and user's secrecy management level" (claim 20). The Examiner's recitation of the claims fails to amount to a teaching or suggestion in the asserted reference, that the asserted reference (i.e., the English-language abstract of **Ishii**) in fact teaches the asserted claim limitations.

Applicants further submit that **Ishii** is factually deficient in that the decision whether the copy protection is cancelled or not is based only upon an ID number given to a user, and no security level is imparted to a document itself. **Ishii** therefore fails to teach or suggest, for example, the claimed aspects of the "secrecy management means", which includes "storage secrecy management information" above and beyond a "user's secrecy management level".

As to independent claims 22 and 25, Applicants submit that the Examiner's comments regarding **Omura** on page 9 of the Office Action are incorrect. Applicants submit that, in the underlying substantive document of **Omura**, data that is to be an object of the copying does not contain either of created ID information, chip ID information, and mail address, as asserted by the Examiner. Consequently, Applicants submit that **Omura** does not, whether taken singly or in combination with the teachings of **Hiraishi** and **Funada**, cure the factual deficiencies of the base references and therefore does not teach or suggest the claimed invention for at least the reason that the proffered combination does not teach or suggest a copying device comprising "first specific information extracting means extracting an ID information unique to a specific

device concerned with the preparation of monitoring object data; and information imparting means imparting the ID information to the monitoring object data and preparing a new copied data" (claim 22) or "second specific information extracting means extracting a specific application information unique to software concerned with the preparation of monitoring object data; and information imparting means imparting the specific application information to the monitoring object data and preparing a new copied data."

As to independent claims 30, 33, 36 and 37 Applicants submit that **Ugai** is configured so as to provide a mark on a back of a recording paper when a copy protected information is printed out. The Examiner's detailed (i.e., mirroring the claim language) suppositions regarding the possible meanings behind the English-language abstract of **Ugai** are factually unsupported and insufficient to substantiate or support a *prima facie* case of obviousness.

The present invention is configured so that the analyzing means extract identifier information, such as chip ID information, IP address and mail address, those given to PC concerned with the printing data printed by the printer device, and then add such data to the copy objective data. Claim 30 recites a copying device comprising "extracting means analyzing the copied data and extracting unique information specifying specific software concerned with the preparation of the copied data; and specific information imparting means imparting the extracted unique information to the copied data as new copied data." Claim 33 recites a copying device comprising "extracting means extracting an IP address imparted to the copying device; and specific information imparting means imparting the extracted IP address to the copied data as new copied data." Claim 36 recites "extracting ID information unique to a specific device concerned with the preparation of the monitoring object data; and imparting the ID information to the monitoring object data and preparing a new copied data". Claim 37 recites "extracting

specific application information unique to software concerned with the preparation of the monitoring object data; and imparting the specific application information to the monitoring object data and preparing a new copied data". None of these claim elements are taught or suggested by **Ugai's** teaching of deciding a "mark addition". Applicants submit that **Ugai** does not, whether taken singly or in combination with the teachings of **Hiraishi** and **Funada**, cure the factual deficiencies of the base references and therefore does not teach or suggest the claimed invention for the reasons noted above.

4. ALLOWANCE OF CLAIM 6 REQUESTED

The Examiner failed to state a ground of rejection for claim 6. Allowance of claim 6, which is hereby amended in independent form, is accordingly requested.

CLOSING REMARKS

The Examiner was required, under C.F.R. § 1.104(c), to "cite the best references at his or her command" following a first search that should have covered the invention as described in the specification, as well as the invention claimed and the inventive concepts toward which the claims appear to be directed (see, e.g., MPEP § 904).

The Examiner was also required to reject each claim on all valid grounds available under 37 C.F.R. § 1.104(b) (see also MPEP § 707.07(g); *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997)).

It is concluded that, consistent with consistent with the mandate to avoid "piece-meal" prosecution (see, e.g., *In re Morris*, 127 F.3d 1048 (Fed. Cir. 1997); MPEP § 706.07), the Office Action dated December 11, 2002, set forth the Examiner's best rejections over the best art uncovered during her first search which should have covered "the invention as described in the

specification, as well as the invention claimed and the inventive concepts toward which the claims appear to be directed."

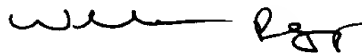
Claims 6-7 and 17-18 have been amended in independent form to include the limitations of based claims 1 and 11, respectively. Claims 1 and 11 are hereby cancelled without prejudice or disclaimer and the dependency of claims 2-4, 10 have been changed. Claim 8 has also been amended in independent form to include the limitations of based claim 1. Claim 8 has additionally been reworded to further clarify the "obtaining the copy inhibition information" step. New dependent claims have been added. It is submitted that the amendments and the new dependent claims added herein do not introduce any new matter or raise any issues that have not already been fully considered by the Examiner.

Therefore, allowance of all of the pending claims is requested. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." See, e.g., *In re Oetiker* 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit excess fees to such account.

Respectfully submitted,

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